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EXAMINER	
NGUYEN, TRAN N	
ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/038,933	COELHO ET AL.	
	Examiner	Art Unit	
	Tran Nguyen	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 05/22/2008. Pending claim(s): 1-24. Cancelled claim(s): 25-27. Amended claim(s): 1, 11, 16.

Response to Amendment

As per the objection to the amendment filed 12/07/2007 under 35 USC 132(a) imposed in the previous Office Action, this objection is hereby withdrawn in view of Applicant's amendment to claims 1, 11, 16.

As per the objection of the specification under 35 USC 112, first paragraph imposed in the previous Office Action, this objection is hereby withdrawn in view of Applicant's amendment to claims 1, 11, 16.

As per the rejection of claims 1-24 under 35 USC 112, first paragraph imposed in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment to claims 1, 11, 16.

As per the rejection of claims 11-15 under 35 USC 101 imposed in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment of claim 11.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 1-24 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, this claim recites "the request includes an intended use of the health information, wherein the intended use is to determine one or more of appropriateness of consent, and requirements for the consent".

First, the grammar of this limitation renders the claim indefinite. In particular, Examiner cannot determine if this is a Markush group based on the punctuation and lack of indentations in the claim.

For the purpose of applying prior art, Examiner interprets this limitation to recite: "the request includes an intended use of the health information, wherein the intended use is to determine one or more of: (a) appropriateness of consent, and (b) requirements for the consent".

Second, Examiner cannot determine the scope of the limitation "the intended use is to determine". In particular, Examiner cannot determine if Applicant intends to recite: (a) that the request itself includes data representing the result of the determination, or (b) the request is used to determine the recited limitations.

For purposes of applying prior art, Examiner interprets this limitation to recite: (b) the request is used to determine the recited limitations, in accordance with the specification. Examiner notes that interpretation (a) above is not supportable by the specification as originally filed.

All claims dependent thereon, namely claims 2-10, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claims 11-24, these claims are rejected for similar rationale above, and incorporated herein.

Additional clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1-3, 8, 16-18, 22 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg (6463417) in view of Rozen (6073106).

As per claim 1, Schoenberg teaches a method (Title) capable of:

(a) controlling access (reads on “transfer”) to a patient’s medical record (reads on “health information”) (column 2 line 36);

(b) distributing medical records over a network (Abstract);

the method comprising:

(a) receiving, by a database server (reads on “an access server”) (Figure 1 label 122) operatively coupled with a network (Figure 1 label 160), a request to access patient medical record (column 5 line 33-36) over an intranet (reads on “an internal network”) (column 4 line 27), wherein the request is generated by a wireless device capable of displaying patient medical records (reads on “a portable healthcare device”) received over the network (column 4 line 43-46);

(b) providing quick access (reads on "immediately") (column 2 line 18) to the patient records stored in the database (column 5 line 47-48), wherein the server system is capable of:

(i) verifying information entered by the physician to uniquely identify a patient (reads on “if a corresponding consent is stored”) (column 6 line 1-7);

(ii) verifying a plurality of security access codes entered by the physician with respect to a plurality of constraints (reads on "whether the consent satisfies requirements for release of the health information") (column 6 line 5-13);

(iii) allowing a physician to request access to at least a portion of a patient record (column 5 line 33-36);

(iv) where the security codes were previously set by the patient (column 4 line 52 to column 5 line 32), wherein the system is capable of protecting patient privacy by providing access to the patient's medical record on a need-to-know basis as determined by the patient with the assistance of a physician (reads on "the consent is provided by an owner of the health information") (column 5 line 50-25, line 2-5);

(v) wherein access is provided on a strict need-to-known basis on a granular level, as discussed in (iv) above (reads on "the consent is based on results provided by a filtering component");

(vi) providing information from the categories in which the received security access codes match the assigned security access codes (reads on "a filtering component… such that an unnecessary portion of the health information is filtered out") (column 6 line 15-21).

Schoenberg further teaches that the request to access information is based on a clinical need to protect patient privacy by withholding medically unnecessary patient data (reads on "the request includes an intended purpose of using the health information, wherein the intended purpose is to determine… an appropriateness of the consent") (column 2 line 7-10), wherein the request is a request for a specific a patient

record (column 2 line 49-50), wherein the security access codes represent a specific portion of the patient record desired to be viewed by the physician (column 2 line 63 to column 3 line 19).

Schoenberg does not teach:

(a) “the request includes an intended use of the health information, wherein the intended use is to determine one or more of appropriateness of the consent, and requirements for the consent";

(b) “wherein a purpose field is provided to satisfy intended reasons for which the health information is access in according to the consent".

Rozen teaches:

(a) asking the requestor if the access for emergency or confidential use (reads on “an intended use”), wherein the emergency E-PIN and/or confidential C-PIN is/are entered (reads on “determine... requirements for the consent") and the appropriate set of medical record is provided (reads on "determine... appropriate of the consent") (Figure 1A column 2);

(b) allowing the requestor to input the type of record (e.g. emergency, confidential, both) requested (Figure 1A), wherein access is provided via a website (reads on “a purpose field”) (column 7 line 40-57).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Rozen within the embodiment of Schoenberg with the motivation of providing access to patient data in emergencies (Rozen; column 4 line 17-28).

Schoenberg further teaches displaying information in the categories that the physician is authorized to view (Figure 2 label 226).

As per claim 2, Schoenberg teaches that the physician is able to use a wireless device to access the system (column 4 line 43-46).

As per claim 3, Schoenberg teaches notifying the requestor if there are problems with the security codes (Figure 2 label 222).

As per claim 8, Schoenberg teaches determining if the received security access codes satisfy the requester identification constraints (reads on "the suitability of a corresponding consent") (column 6 line 11-13).

As per the set of claim(s): 16, 17, 18, 22, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 2, 3, 8, respectively, and incorporated herein.

In particular, Schoenberg teaches software capable of performing the recited functionality (column 4 line 8-51). See MPEP 2106.01(I).

Claim(s) 4-5, 19-20 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg in view of Rozen as applied to parent claims 3, 18, above, and further in view of Edelson (5737539).

As per claim 4, Schoenberg and Rozen do not teach storing the health information remotely from the server.

Edelson teaches a transient virtual record (Abstract) capable of being stored across a plurality of data warehouses (Figure 16, column 8 line 20 to column 9 line 3).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Edelson within the embodiment of Schoenberg and Rozen with the motivation of providing data privacy (Edelson; column 8 line 63 to column 9 line 3).

As per claim 5, Schoenberg teaches using fingerprints (column 5 line 45), retinal scans (column 5 line 44), and security codes (reads on "digital signature data") (column 6 line 1-20) to identify the patient (reads on "comparing the corresponding consent with stored consent data") (column 5 line 37-45).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 19, Schoenberg teaches re-authenticating the requestor (Figure 2 label 219, 220, 222).

Schoenberg and Rozen do not teach storing the health information remotely.

Edelson teaches a transient virtual record (Abstract) capable of being stored across a plurality of data warehouses (Figure 16, column 8 line 20 to column 9 line 3).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Edelson within the embodiment of Schoenberg and Rozen with the motivation of providing data privacy (Edelson; column 8 line 63 to column 9 line 3).

As per the set of claim(s): 20, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 5, respectively, and incorporated herein.

Claim(s) 6, 21 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg in view of Rozen as applied to parent claims 1, 16 above, and further in view of Snowden (20020026332) and Edelson.

As per claim 6, Schoenberg and Rozen do not teach “determining if consent is required".

Snowden teaches accessing anonymous patient data (reads on “determining if consent is required”) (page 7 paragraph 0123).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Snowden within the embodiment of Schoenberg and Rozen with the motivation of providing economic benefits (Snowden; page 7 paragraph 0122).

Schoenberg, Rozen, and Snowden do not teach storing the health information remotely.

Edelson teaches a transient virtual record (Abstract) capable of being stored across a plurality of data warehouses (Figure 16, column 8 line 20 to column 9 line 3).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Edelson within the embodiment of Schoenberg, Rozen, and Snowden with the motivation of providing data privacy (Edelson; column 8 line 63 to column 9 line 3).

As per the set of claim(s): 21, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, respectively, and incorporated herein.

Claim(s) 7 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenberg in view of Rozen as applied to parent claim 1 above, and further in view of Applicant Admitted Prior Art (AAPA).

As per claim 7, Schoenberg teaches that the system is capable of being used by any medical care provider requestor (column 2 line 35-39).

Schoenberg and Rozen do not teach “a pharmacy benefit manager”.

AAPA teaches PBM's accessing patient data (Specification; page 3 paragraph 0004).

All component parts are known. The only difference is the combination of “old elements” into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of Schoenberg and Rozen, since the operation of the requestor is in no way dependent on medical record system, and a standard requestor may be used with a record system to achieve the predictable result of accessing the data contained therein.

Claims 9-13, 23-24 are 35 U.S.C. 103(a) as obvious over Schoenberg in view of Rozen as applied to parent claims 1, 16 above as applicable, and further in view of AAPA.

It is noted that the official notice taken in the previous Office Action is taken to be AAPA because Applicant failed to adequately traverse Examiner's assertion.

As per claims 9-10, Schoenberg teaches Internet communication (Figure 1 label 160).

Schoenberg does not teach “a wrapper for acceptance by a next segment in the network pathway”.

Schoenberg teaches TCP/IP over the Internet (column 4 line 26-27).

AAPA teaches that the Internet is a plurality of interconnected routers, wherein data is routed from a source to a destination based on the TCP/IP protocol, wherein a destination is attached to the data (reads on "a wrapper"). According to the TCP/IP

protocol, when a router receives data, the router forwards the data to the next router on the network for delivery to the final destination. At the final destination, the TCP/IP data is dropped, leaving the original data.

All component parts are known. The only difference is the combination of "old elements" into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of Schoenberg and Rozen, since the operation of the Internet is in no way dependent on the medical record system, and a standard network communication protocol may be used with a network to achieve the predictable result of transferring data between remote computers.

As per claim 11, Schoenberg teaches a system (Title) comprising:

(a) a server (Figure 1 label 120) comprising:

(i) a data processor (column 4 line 16-24);

(ii) memory capable of storing instructions and results of calculations performed by the data processor (column 4 line 16-24);

(iii) an intranet network interface (reads on "an internal network port) (column 4 line 27);

(iv) a network interface ("a server interface") (column 4 line 25-29);

(v) software (reads on “a consent processing system”) capable of providing access to patient data based on the level of access granted by the patient (Abstract and throughout), comprising:

(1) a database (reads on “consent database”) (column 3 line 20-20-25);

(2) software (reads on "a search engine") capable of processing request for information by accessing the database (column 3 line 20-49);

(b) the intranet network interface capable of receiving, by a database server (Figure 1 label 122) operatively coupled with a network (Figure 1 label 160), a request to access patient medical record (column 5 line 33-36) over an intranet (column 4 line 27), wherein the request is generated by a wireless device capable of displaying patient medical records (reads on “a portable healthcare device”) received over the network (column 4 line 43-46);

(c) wherein the database is capable of storing access privileges granted by the patient (reads on “consents“) (column 3 line 20-20-25);

(d) wherein the server system is capable of:

(i) verifying information entered by the physician to uniquely identify a patient (reads on “if a corresponding consent is stored”) (column 6 line 1-7);

(ii) verifying a plurality of security access codes entered by the physician with respect to a plurality of constraints (reads on "whether the consent satisfies requirements for release of the health information”) (column 6 line 5-13);

(iii) allowing a physician to request access to at least a portion of a patient record (column 5 line 33-36);

(iv) where the security codes were previously set by the patient (column 4 line 52 to column 5 line 32), wherein the system is capable of protecting patient privacy by providing access to the patient's medical record on a need-to-know basis as determined by the patient with the assistance of a physician (reads on "the consent is provided by an owner of the health information") (column 5 line 50-25, line 2-5);

(v) wherein access is provided on a strict need-to-known basis on a granular level, as discussed in (iv) above (reads on "the consent is based on results provided by a filtering component");

(vi) providing information from the categories in which the received security access codes match the assigned security access codes (reads on "a filtering component… such that an unnecessary portion of the health information is filtered out") (column 6 line 15-21).

Schoenberg further teaches that the request to access information is based on a clinical need to protect patient privacy by withholding medically unnecessary patient data (reads on "the request includes an intended purpose of using the health information, wherein the intended purpose is to determine… an appropriateness of the consent") (column 2 line 7-10), wherein the request is a request for a specific a patient record (column 2 line 49-50), wherein the security access codes represent a specific portion of the patient record desired to be viewed by the physician (column 2 line 63 to column 3 line 19).

Schoenberg does not teach:

(a) “the request includes an intended use of the health information, wherein the intended use is to determine one or more of appropriateness of the consent, and requirements for the consent";

(b) “wherein a purpose field is provided to satisfy intended reasons for which the health information is access in according to the consent".

Rozen teaches:

(a) asking the requestor if the access for emergency or confidential use (reads on “an intended use”), wherein the emergency E-PIN and/or confidential C-PIN is/are entered (reads on “determine... requirements for the consent") and the appropriate set of medical record is provided (reads on "determine... appropriate of the consent") (Figure 1A column 2);

(b) allowing the requestor to input the type of record (e.g. emergency, confidential, both) requested (Figure 1A), wherein access is provided via a website (reads on “a purpose field”) (column 7 line 40-57).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Rozen within the embodiment of Schoenberg with the motivation of providing access to patient data in emergencies (Rozen; column 4 line 17-28).

Schoenberg further teaches displaying information in the categories that the physician is authorized to view (Figure 2 label 226) over the Internet (column 2 line 60-61). Schoenberg further teaches TCP/IP over the Internet (column 4 line 26-27).

AAPA teaches that the Internet is a plurality of interconnected routers, wherein data is routed from a source to a destination based on the TCP/IP protocol, wherein a destination is attached to the data (reads on "a wrapper"). According to the TCP/IP protocol, when a router receives data, the router forwards the data to the next router on the network for delivery to the final destination. At the final destination, the TCP/IP data is dropped, leaving the original data.

All component parts are known. The only difference is the combination of “old elements” into a single embodiment.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of Schoenberg and Rozen, since the operation of the Internet is in no way dependent on the medical record system, and a standard network communication protocol may be used with a network to achieve the predictable result of transferring data between remote computers.

As per the set of claim(s): 12, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 8, respectively, and incorporated herein.

As per claim 13, this claim is rejected for substantially the same rationale as applied to claim 9 above, and incorporated herein.

In particular, Schoenberg teaches using the Internet to route data between the database and the requestor (Figure label 160).

As per the set of claim(s): 23, 24, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 9, 10, respectively, and incorporated herein.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as obvious over Schoenberg in view of Rozen and AAPPA as applied to parent claim 11 above, and further in view of de la Huerga (5903889).

As per claims 14-15, Schoenberg, Rozen, and AAPA do not teach determining the type of information received and determining an appropriate software application program therefor.

De la Huerga teaches processing patient data based on the data type of the patient data (column 3 line 55-65).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of de la Huerga within the embodiment of Schoenberg, Rozen, and AAPA with the motivation of providing interoperability (de la Huerga; column 1 line 53-65).

Response to Arguments

Applicant's arguments filed 05/22/2008 have been fully considered but they are not persuasive.

On page 11 Applicant argues that Schoenberg does not teach "the request includes an intended use of the health information, wherein the intended use is to determine one or more of appropriateness of the consent, and requirements for the consent, wherein a purpose field is provided to satisfy intended reasons for which the health information is access in according to the consent".

First, this is a newly added limitation that was never presented before during prosecution.

Second, in making this argument, on page 11 Applicant asserts "Referring now to the section relied upon the Examiner (for a particular feature of claim1)..." Examiner submits that Applicant's assertion is not supportable by the Official file because this limitation was not previously presented. Therefore it is not possible for Applicant to refer to a section relied on by Examiner for this limitation because the rejection did not address features not claimed.

Third, on page 11 Applicant asserts column 2 line 7-10 of Schoenberg, which teaches "*while information regarding the patient's blood type and allergies might be necessary for the proper treatment of the injury, the patient's cardiological or serological data is not. None of the above methods can prevent unnecessary medical data from being divulged to the medical care provider, thus potentially risking the patient's privacy*"

(emphasis in Applicant's Remarks). Examiner submits that in addition to the reasons stated above, Applicant's argument is not persuasive because this particular section of the applied art is present in the background of the invention, wherein Schoenberg discusses the problem with the current state of the art. Schoenberg goes on to teach solutions to this problem with his invention (column 2 line 16-22).

Fourth, Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

As per claims 9-13, 23-24, on page 13 Applicant argues “Applicants respectfully disagree with the Examiner’s Official Notice and request the Examiner provide additional evidence and details to justify the Official Notice”.

MPEP 2144.03(C) reads as follows: " To adequately traverse such a finding [of official notice], an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b)…

If… applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because… the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.”

Applicant’s traversal of the Official Notice is considered to be inadequate because Applicant did not specifically point out the supposed errors in Examiner’s

action, including stating why the noticed fact is not considered to common knowledge or well-known in the art in accordance with MPEP 2144.03(C).

Assuming *arguendo* that Applicant's traversal is adequate, Examiner submits Lakshman (The performance of TCP/IP for networks with high bandwidth-delay products and random loss). Lakshman teaches that TCP/IP is the most popular data transfer protocol in current use for Internet communication (page 336 column 1 paragraph 3).

Lakshman further teaches popular Tahoe and Reno versions, wherein data is segmented into packets for transmission to the destination (page 336 column 2 paragraph 2 and throughout).

Therefore, the Official Notice previously taken is considered to be AAPA.

As per claim 11, on page 13 Applicant asserts "Applicants request the Examiner explain the rejection of each and every element of claim 11" (emphasis in original).

In making this argument, on page 13 Applicant asserts "claim 1[1] contains limitations similar to those of claim 1 and 16" (Examiner assumes Applicant is discussing claim 11 even though Applicant omitted the digit "1").

First, MPEP 706 states that "The goal of examination is to clearly articulate any rejection". Nowhere is "clearly articulate" taken to mean "explain each and every element of a claim".

Second, Applicant has admitted that claim 11 contains limitations similar to those of claims 1 and 16. Claim 11 recites a system, whereas claims 1, 16 recite automated

methods. Examiner previously indicated in the previous Office Action that all structural elements in claim 11 could be construed to be software *per se* elements (page 4-5). Therefore, software capable of performing the recited functionality, as explained in the rejection of claim 1, is considered to be a clear articulation of the claimed structural elements.

Nevertheless, in the interest of compact prosecution for Applicant, Examiner has provided in-depth discussion of claim 11 above for Applicant's consideration.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Kessler (20010034618) teaches PBMs working closely with physicians to administer benefits and monitor compliance.

Fenner (5095480) teaches the general state of the art in network communication.

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626

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